REMARKS

Claims 1-15 and 26-30 are pending. Claims 1-7 and 9-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,546,523 to Gatto in view of U.S. Patent No. 6,028,950 to Merjanian. Claims 8 and 26-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,546,523 to Gatto in view of U.S. Patent No. 6,028,950 to Merjanian and U.S. Patent No. 5,485,510 to Colbert.

Reconsideration is requested. No new matter is added. The rejections are traversed. Claims 1-15 and 26-30 remain in the case for consideration.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103(a)
RESPONSE REGARDING CLAIMS NEVER SPECIFICALLY REJECTED

The Examiner rejected claims 1-7 and 9-15 under 35 U.S.C. § 103(a). In the Office Action dated October 22, 2002 – three Office Actions ago – the Examiner indicated specific limitations from the claims that the Examiner thought were taught by the cited references. The limitations identified by the Examiner are drawn only from claims 1, 4, and 7. As the Examiner did not specifically explain why claims 2-3, 5-6, and 8-15 should be rejected, the Applicant believes these claims should be independently allowable. This oversight was pointed out in the Amendment filed February 21, 2003, and again in the Preliminary Amendment filed October 3, 2003. The Office Action dated December 2, 2003, still does not address claims 2-3, 5-6, and 8-15. For example, claim 9 describes the registration of a non-unique payor personal identification number with the electronic third party identicator, which is not taught by any of the prior art references.

RESPONSE TO SPECIFIC REJECTIONS

Referring to claim 1, the invention is directed toward a method for tokenless authorization of an electronic payment. The payor registers with a third party identicator a biometric sample and a financial account identifier. A bid biometric sample is collected from the payor. The bid biometric sample is forwarded to the third party identicator. The third party identicator compares the bid biometric sample with registered biometric samples to either successfully or unsuccessfully identify the payor. If the payor is successfully identified, the third party identicator forwards the financial account identifier to the payee. An electronic transaction is formed between the payor and the payee, and forwarded to a financial institution for authorization. Once authorized, funds are transferred from the

payor's financial account to the payee. Claim 29 is similar to claim 1, further including steps of payee registration and payee identification.

In contrast, Gatto teaches an electronic fund transfer system. To simplify use by customers, Gatto allows the customer to define custom transactions. Using custom transactions, customers are not limited to the predefined transactions offered by electronic fund transfer systems. For example, as stated in column 1, lines 30-36, ATMs permit users to automatically select amounts of cash for withdrawal, but the choices are limited and constant for all users. Instead of limiting users to these choices, Gatto allows the customers to define their own transactions (such as withdrawing $25 instead of other fixed amounts: see column 4, lines 62-64).

Colbert teaches a secure credit/debit card authorization system. When a customer wants to purchase something from a vendor, rather than giving out their card number, they provide an authorization number. The authorization number is provided by the company that issued the customer's card, is specific to the transaction between the customer and the vendor, and may be limited in amount or time. The vendor can use the authorization number once to make the sale, after which the authorization number is no longer valid.

Merjanian teaches a fingerprint controlled set-top box. The user uses a fingerprint to engage in transactions. The user's fingerprint is scanned by the set-top box and compared with a previously known fingerprint sample. If the scanned fingerprint matches the sample, then the user's account is billed for purchases made.

As the Examiner has relied primarily on Gatto in rejecting the claims, Gatto is considered the primary reference, and Colbert and Merjanian are considered only to the extent the Examiner has applied the references. Colbert and Merjanian do not teach any of the other limitations of the claims.

In responding to the Applicant's arguments in the amendment dated October 3, 2003, the Examiner disagreed with the argument made with respect to claim 1. Instead, the Examiner contends that Gatto teaches forwarding the payor financial account to the payee. The Examiner mentions that Gatto discloses use of the invention with POS terminals, and cites to column 8, lines 40-55 to support the position that Gatto teaches payment by ATM or VISA. The Examiner then contends that the payee needs the payor's financial account information to get authorization for the transaction.

There are at least two problems with the Examiner's argument. First, the final contention (that the payee needs the payor's financial account information) is simultaneously irrelevant and wrong. It is irrelevant because this contention was not the feature the

Applicant was arguing distinguishes the invention. The Applicant was arguing that in the claimed invention the payee was getting the payor's financial account information *from a different source* than from which the payee receives this information in Gatto. It is wrong because it is entirely possible to complete a transaction without the payee ever knowing the payor's financial account information. As an example of this, the Examiner is referred to Colbert, cited by the Examiner in rejecting the pending claims, which teaches a way to authorize a credit card transaction without the payee knowing the payor's financial account information.

Second, the Applicant disagrees with the Examiner that Gatto teaches the payor's financial account information being forwarded to the payee. Gatto frequently describes the information in question as being *stored and accessed locally*, and nowhere describes this information being received from some remote location. For example, at column 4, line 43, Gatto says "the controller uses the stored information," and at column 5, lines 43-44: "the system may store information." There is no description of how this information is *retrieved*; without such a description Gatto cannot be said to teach or suggest receiving the payor's financial account information from any source other than the local storage.

In fact, there is significant teaching to the contrary, that Gatto stores the financial account information on the identification card. They begin in the abstract, where the "user-defined custom transactions [are] associated with an identification card." This theme is repeated in Gatto's summary of the invention at column 2, lines 11-16, which describes the identification card as enabling the use of custom transactions, and all other references to custom transactions are directly tied to the identification card. To read Gatto as supporting the proposition that custom transactions are stored anywhere but on the identification card is to be reaching so far off the tree as to be unsupported by even the thinnest of branches.
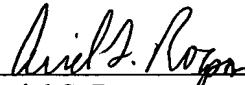
Finally, the Examiner argued that the Applicant relied on a term not in the claims: specifically, the term "computer data processing center." The Examiner is correct that this term does not appear in the claims. The Applicant meant to refer to the "electronic third party identicator" mentioned in the claims. The electronic third party identicator is described as "register[ing] . . . at least one payor financial account identifier," and later as "forward[ing] at least one payor financial account identifier to the payee." Accordingly, the Examiner is requested to interpret the argument in question as having discussed the "electronic third party identicator" instead of the "computer data processing center."

The Applicant restates all of the arguments made in the previous Response to Office Actions here by reference.

For the foregoing reasons, reconsideration and allowance of claims 1-15 and 26-30 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

Ariel S. Rogson
Reg. No. 43,054

MARGER JOHNSON & McCOLLOM, P.C.
1030 SW Morrison Street
Portland, OR 97205
503-222-3613
Customer No. 20575